

REMARKS

This amendment, submitted in response to the Office Action dated February 6, 2003, is believed to be fully responsive to each point of rejection raised therein. Accordingly, favorable reconsideration on the merits is respectfully requested.

With the reopening of *ex parte* prosecution in this case, claims 1-2 and 4-21 have now been treated on the merits. Claims 6-11 and claims 12/6-11 and 13-17 remain withdrawn from further consideration as being directed to a non-elected claim. Claim 18 has been rejected under 35 U.S.C. § 112, first paragraph, as not being supported by the specification. Claims 1, 12/1 and 18-21 have been rejected under 35 U.S.C. § 103 as being unpatentable over Takanashi in view of Michelson. Claims 2, 4-5, 12/2/1 and 12/5/1 have been rejected under 35 U.S.C. § 103 as being unpatentable over Takanashi in view of Michelson and further in view of Fujimura. Claims 2 and 17 have been rejected under 35 U.S.C. § 103 as being unpatentable over Takanashi in view of Michelson and further in view of Koguchi. All references are previously of record. Applicant submits the following comments in traversal of the art rejections.

With regard to the Section 112 rejection of claim 18, Applicant hereby cancels claim 18 without prejudice or disclaimer to expedite prosecution of the case.

Turning to the prior art rejections, Applicant's invention relates to an image recording method. A description of the background and exemplary embodiment are set forth in the Brief on Appeal at page 2. Descriptions of Takanashi, Michelson, Fujimura and Koguchi are set forth in the Brief at pages 6-7. Applicant directs the Examiner's attention to these discussions.

The Examiner maintains essentially the same prior art rejections as the Final Office Action of March 26, 2002. Therefore, Applicant would maintain that the arguments of record in

the Brief on Appeal remain pertinent. The Examiner has also offered a number of rebuttal arguments in the Response to Arguments section. Applicant's arguments to the Response are set forth below.

In the Response to Arguments identified as item (a), the Examiner correctly notes that Michelson requires an overhang of recording materials since Michelson depends on suctioning supplied internally from the drum for purposes of positioning toner sheets. In direct contrast, Takanashi teaches alignment of a binder layer and recording sheet, a non-overlapping condition. The Examiner concedes this alignment occurs relative to Response to Arguments (b) and (d). The positioning of Michelson is provided by overlap, and that of Takanashi is providing by alignment. Significantly, the alignment is provided placing a leading end of the binder with thermal head. Edge detectors determine when the ink transfer can begin. Col. 4, lines 4-13. The fundamental issue as to whether the references can be combined is why one skilled in the art would apply the toner sheets to the recording material in Takanashi in view of these differences.

As a related matter, Michelson permits positioning of sheet through vacuum suction and overlap of the toner and the recording medium. However, the suctioning arrangement is not appropriate in Takanashi due to the wax-like binder (impermeable to suction) and the alignment of materials that do not permit positioning of a toner on a recording drum by overlapping edges. See Fig. 5a, 9b is aligned with 9a; col. 1, lines 54-55. Rather, Takanashi relies on movements of the thermal recording head physically against the ink layer and recording drum to align the ink and the recording sheet and to provide transfer of the ink. See col. 2, lines 54-57; col. 3, lines 23-28. The movement of the printing head and the alignment of the ink transfer sheet result from

the ink layer being supplied under a tension between a supply reel 8a and take up reel 8b. This arrangement is not possible using a cut sheet form.

The Examiner contends, with regard to item (c), that Michelson provides ample ways to provide a cut sheet toner in Figs. 3a-3f. However, Figs. 3c -3f in particular illustrate the suction and overlap positioning, which as discussed above, is contrary to the alignment in Michelson. In addition, the supply tray 5 would prevent contact of the ink sheet and a recording head at a point of alignment of the recording materials as set forth in Takanashi. This distinction is attributable to the fact that Takanashi relies on thermal contact for operation and Michelson does not. Figs. 3c-3f do not adequately demonstrate how a toner sheet can be positioned in Takanashi based on the teachings of Michelson.

With further regard to item (c), the benefits of providing sheets instead of a roll is purportedly to supply different colors during printing. However, since Takanashi permits a continuous roll to provide multiple colors (See Fig. 4), then the flexibility of providing different colors in different sections is still achievable using a continuous roll. The purported disadvantage of using a roll is obviated in Takahashi, by using a particular type of continuous roll. The motivation to combine is negated by the cited art.

With regard to arguments (e)-(g), the Examiner contends that it is not required that features of the references be bodily incorporated. However, the combination cannot change the principle of operation of the references. In this case, the principles of operation would be changed with regard to at least three points. The first pertains to positioning of the ink sheets onto the recording drum. Takanashi includes positioning under tension of the recording

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materials, whereas Michelson provide position under suction. The second pertains to alignment. Takanashi relies on alignment of materials, whereas Michelson requires overlap of materials. The third pertains to the type of recording (contact recording and non-contact recording). It is in at least three respects that the references would require a redesign in a manner not suggested by the art. In re Ratti, 123 USPQ 349, 352 (CCPA 1959).

In view of the foregoing and those arguments previously of record, Applicant would maintain that the rejections of the independent claims should be withdrawn. The remaining claims are patentable based on their dependency, and the additional Koguchi and Fujimura references do not make up for the above deficiencies.

Claim 22 has been added to clarify that the image receiving sheet is provided only once even if a color image recording is performed. By contrast, referring to Figs. 4 and 5 of Takahashi, the binder and coloring layer must be disposed multiple times for color recording.

In view of the above, Applicant submits that claims 1, 2, 4, 5, 12/1-2, 12/4-5, 17 and 19-22 are in condition for allowance. Therefore it is respectfully requested that the subject application be passed to issue at the earliest possible time. The Examiner is requested to contact the undersigned at the local telephone number listed below to discuss any other changes deemed necessary.

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The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

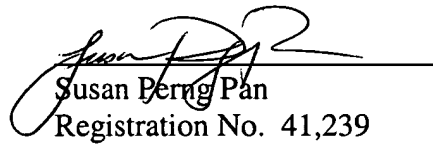
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APPENDIX

VERSION WITH MARKINGS TO SHOW CHANGES MADE

IN THE CLAIMS:

Claim 18 is canceled.

Claim 22 is added as new claims.